

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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Ex parte NAGABHUSHANA T. SINDHUSHAYANA and JACK K. WOLF

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Application No. 09/965,518

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ORDER RETURNING UNDOCKETED APPEAL TO EXAMINER

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This application was electronically received at the Board of Patent Appeals and Interferences (BPAI) on February 9, 2007. A review of the application has revealed that the application is not ready for docketing as an appeal. Accordingly, the application is wherewith being returned to the Examiner. The matters requiring attention prior to docketing are identified below.

On February 5, 2007, the Examiner mailed a communication acknowledging receipt of Appellants' Reply Brief, dated January 8, 2007. A review of the Response to Reply Brief reveals that the Examiner did not provide proper acknowledgment. The comments made by the Examiner would constitute being a Supplemental Examiner's Answer.



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The Examiner's response to Reply Brief as set forth in MPEP § 1208, which states:

(1) After receipt of a reply brief in compliance with § 41.41, the primary examiner must acknowledge receipt and entry of the reply brief. In addition, the primary examiner may withdraw the final rejection and reopen prosecution or may furnish a supplemental examiner's answer responding to any new issue raised in the reply brief.

(2) A supplemental examiner's answer responding to a reply brief may not include a new ground of rejection.

(b) If a supplemental examiner's answer is furnished by the examiner, appellant may file another reply brief under § 41.41 to any supplemental examiner's answer within two months from the date of the supplemental examiner's answer.

A review of the Response to Reply Brief reveals that the Examiner did not provide proper approval.

On November 9, 2006, an Examiner's Answer was mailed. A review of the Examiner's Answer reveals that it is not in compliance with the headings as required under 37 CFR § 41.37(c).

An in-depth review of the Examiner's Answer mailed on November 9, 2006, reveals that under the heading Evidence Relied Upon, all of the prior arts relied on was not listed. Xu, U.S. 20010052104 was not listed under the heading Evidence Relied Upon, but was used in rejecting claims 15 and 16 under 35 U.S.C. § 103(a) on page 14, of the Examiner Answer. The MPEP 1207.02(A) states:

A) CONTENT REQUIREMENTS FOR EXAMINER'S ANSWER. The examiner's answer is required to include, under appropriate headings, in the

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order indicated, the following items:

(8) *Evidence Relied Upon*. A listing of the evidence relied on (e.g., patents, publications, admitted prior art), and, in the case of nonpatent references, the relevant page or pages.

Proper correction of the Examiner's Answer is required.

Accordingly, it is ORDERED that the application is return to the Examiner:

- 1) vacate the Examiner Acknowledgment to the Reply Brief mailed February 5, 2006; proper acknowledgment of the Reply Brief is required; and
- 2) issue and mail a PTOL-90, citing all references used in the rejection Of the appealed claims; and
- 3) for such further action as may be deemed appropriate.

BOARD OF PATENT APPEALS  
AND INTERFERENCES



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PJN/pgc

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